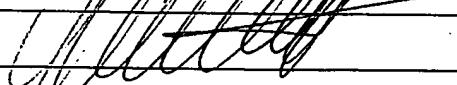
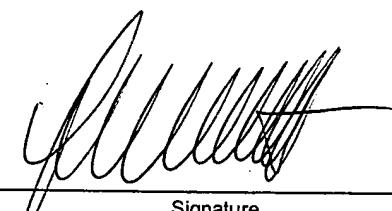


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>REICHSTEIN</b>
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>December 12, 2005</u></p> <p>Signature: </p> <p>Typed or printed name <u>HENRY M. FEIEREISEN</u></p>		<p>Application Number <b>10/603,459</b></p> <p>Filed <b>June 25, 2003</b></p> <p>First Named Inventor <b>Ulrich Reichstein et al.</b></p> <p>Art Unit <b>1722</b></p> <p>Examiner <b>Heitbrink, T. W.</b></p>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>31,084</u> Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		 <p>Signature <b>HENRY M. FEIEREISEN</b></p> <p>Typed or printed name</p> <p><u>(212) 244-5500</u></p> <p>Telephone number</p> <p><u>12-12-2005</u></p> <p>Date</p>
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<p><input checked="" type="checkbox"/> *Total of <u>3</u> forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## ARGUMENTS ACCOMPANYING THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

The present invention, as set forth in claim 1, is directed to an injection molding machine with a machine control, and electric components, whereby the machine control and the electric components are operatively connected in wireless mode. In response to the first Office Action, dated March 9, 2005, claim 1 was amended to set forth that the machine control as well as the electric components are internal parts of the injection molding machine. Claim 1 has been finally rejected by the Examiner pursuant to 35 U.S.C. §112, first and second paragraphs because the reference to "internal" is considered "new matter" and considered "indefinite".

### ISSUE 1:

Rejection of Claims 1-4 under 35 U.S.C. §112, first paragraph

CLEAR ERROR IN THE EXAMINER'S REJECTION: Interpretation of the reference to "internal" as new matter.

Reference is made to page 6, first paragraph, of applicant's previous communication, filed July 5, 2005.

Reference is made to paragraph [0003] of the instant specification, noting the connection between the electric components to a machine control and/or to an **external** computer. This paragraph distinguishes between the parts of the injection molding machine, namely electric components and machine control and an external part, namely external computer. Thus, while not expressly referring to "internal", it is appellant's contention that this paragraph unambiguously implies that the electric components and the machine control are "internal" parts.

Reference is made to paragraph [0011] of the instant specification and claim 4, which set forth the provision of an **external** device. The express

reference to an external device, again, is intended to distinguish from the “internal” parts, set forth in claim 1. Otherwise the use of “external” would serve no purpose.

Reference is made to paragraph [0017] of the instant specification, listing plural components, including machine control and electric components, of the injection molding machine that are provided on the machine (line 5, of paragraph [0017]). An example of an electric component operatively connected to the machine control is a temperature sensor (paragraph [0018]) for measuring the temperature of plastic melt in the hot runner of the injection molding machine. Although not stated expressly, the temperature sensor clearly constitutes an “internal” part of the injection molding machine.

In summary, ample support can be found inherently in the original specification for the term “internal”. (see *In re Nathan*, 328 F.2d 1005, 140 USPQ 601 (C.C.P.A. 1964), stating that a “subsequent clarification of or a change in an original disclosure does not necessarily make that original disclosure fatally defective.”). It is applicant’s belief that the instant specification satisfies the requirement under section 112, first paragraph.

For the reasons set forth above, it is respectfully requested to reverse the rejection of claim 1 and all claims dependent on claim 1 under 35 U.S.C. §112, first paragraph.

#### ISSUE 2:

##### Rejection of Claims 1-4 under 35 U.S.C. §112, second paragraph

CLEAR ERROR IN THE EXAMINER’S REJECTION: Reference to “internal” renders claim 1 indefinite.

As discussed under the previous heading, there is ample support in the original specification for the term “internal” in connection with the machine control and electric components as forming internal parts of the injection molding machine. Nothing in the disclosure suggests any reference to a “room”, as the

Examiner noted. The inherency of the term "internal" as well as the actual use of the term "external" are unambiguous, and clearly relate to the injection molding machine, namely as part thereof ("internal") or to areas remote to the injection molding machine ("external").

For the reasons set forth above, it is respectfully requested to reverse the rejection of claim 1 and all claims dependent on claim 1 under 35 U.S.C. §112, second paragraph.

ISSUE 3:

Rejection of Claim 1 under 35 U.S.C. §102(b)

**CLEAR ERROR IN THE EXAMINER'S REJECTION:** Absence of each and every element of the claimed invention in a single prior art reference disclosure.

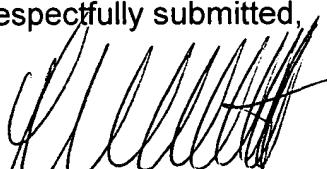
Reference is made to page 6, second and third paragraphs and page 7, of applicant's previous communication, filed July 5, 2005.

Claim 1 sets forth the wireless communication between machine-internal parts, namely machine control and electric components. This claim limitation is neither expressly nor inherently disclosed in the applied prior art.

For the reasons set forth above, it is respectfully requested to reverse the rejection of claim 1 and all claims dependent on claim 1 under 35 U.S.C. §102(b).

Respectfully submitted,

By: \_\_\_\_\_

  
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